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Xerox Docket No. D/97427

AF/2134

PATENT APPLICATION

RESPONSE UNDER 37 CFR §1.116  
EXPEDITED PROCEDURE  
TECHNOLOGY CENTER ART UNIT 2134 (N.E.)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#32

In re the Application of

James D. THORNTON et al.

Group Art Unit: 2134

Application No.: 08/976,579

Examiner: C. Brown

Filed: November 24, 1997

Docket No.: JAO 34191

For: PAPER DOCUMENT SATCHELS

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

**RECEIVED**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

NOV 14 2003

Technology Center 2100

Sir:

In reply to the September 26, 2003 Final Office Action, please reconsider the application in light of the following remarks.

Claims 29-37 and 39-45 are pending.

As part of Applicants' response to the merits of the rejection, Applicants will discuss the Examiner's Response to Amendment, found on page 3 of the Office Action.

With respect to claims 29-37 (claim 38 having been cancelled), the Office Action indicates that the recitation "that point to another document" has not been given patentable weight "because the recitation occurs in the preamble."

The first reason stated for this position is that "[A] preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a

structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone."

The Office Action then states that "[T]he device used in the rejection of the instant specification is suitable to read any information. The device makes no distinction between links that point to other documents or the same documents."

In the first place, the quotation of a general statement regarding claim preambles, as in the Office Action, has no evidentiary weight absent an application of that principle to the claims. Because the Office Action does not apply that general statement to the claims, the quotation itself provides no evidence as to the patentable weight to be accorded to the preamble.

In the second place, the Office Action fails to demonstrate what "the device used in the rejection of the instant specification" has to do with the patentable weight to be accorded to the preamble of the claims of this application. What is in issue with respect to whether a claim preamble is to be given patentable weight is the claim language itself, not the reference applied in the rejection of that claim.

Claims 29 and 32 are "system" claims in which the preamble recites "tokens encoded in a document that point to another document" and in which the body of the claims expressly refers back to those tokens by reciting a decoder that decodes a number of "such tokens" and a selector that lists a number of "such tokens." Claims 30-31 depend from claim 29 and contain the positively recited features of claim 29. Claim 33 depends from claim 32 and contains the positively recited features of claim 32. Claim 34 is a method claim in which the preamble recites "using user-selectable tokens encoded in a document that point to another document" and in which the body of the claim expressly refers back to those tokens by

reciting decoding at least one "such user selectable token." Claim 35 depends from claim 34 and contains all the features of claim 34.

Claim 36 and 37 are system claims in which the body of the claim recites tokens that have been embedded in the paper document and that point to another document. The preamble is not even in issue in these claims. Yet, the Office Action improperly addresses these claims as though the preamble is in issue.

With respect to claims 29-35, in which the preamble is in issue, the Court of Appeals for the Federal Circuit ("Federal Circuit") clearly stated, in Eaton Corp. v. Rockwell International Corp., 66 USPQ2d 1271, 1276 (Fed. Cir. 2003), citing Pitney Bowes, Inc. v. Hewlett-Packard Co., 51 USPQ2d 1161, 1165 (Fed. Cir. 1999), that a claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use *both* the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.

In this application, the claim preambles define tokens as tokens that point to another document, and the bodies of the claims provide the same definition by explicitly referring to "such tokens."

Moreover, the Federal Circuit has stated in In re Cruciferous Sprout Litigation, 64 USPQ2d 1202, 1204 (Fed. Cir. 2002), that clear reliance on the preamble during the prosecution to distinguish the claims from the prior art may indicate that the preamble is a claim limitation because the preamble is used to define the claimed invention. The court went on to state that in the Cruciform case, both the specification and the prosecution history indicates that a preamble phrase helped to define the claimed invention and, therefore, was a limitation of the patent.

In this application, the prosecution history includes Applicants' assertion that the preamble is a positively recited feature of the claims. Moreover, the specification itself supports this conclusion. In this regard, please note the statement on page 1 of the specification, in the "Field of the Invention" that " . . . the invention is directed to encoding areas of a paper document so that those areas may be scanned into a processing system in order to access additional documents, information, etc." (emphasis added).

With respect to claims 36 and 37, the tokens that point to another document are positively recited in the body of the claim. The failure of the Office Action to give this feature patentable weight is considered to be clearly improper.

For at least the foregoing reasons, Applicants respectfully submit that recitation of tokens "that point to another document" should be accorded patentable weight.

The Office Action rejects claims 29-38 under 35 U.S.C. §102(b) over U.S. Patent No. 5,905,246 to Fajkowski. This rejection is moot with respect to cancelled claim 38 and respectfully traversed with respect to the remaining claims.

The Office Action alleges that col. 3, lines 51-62 of Fajkowski discloses a system for decoding tokens and using tokens encoded in a document "by means of a barcode embedded in a coupon." Applicants respectfully disagree.

Applicants define a "token" on page 2 of the specification, lines 10-13, as (1) having two parts, the reference and the access information, and as (2) "a pointer to a document, not a copy of a document." Claims 29-37 recite tokens that point to another document, a feature totally lacking in Fajkowski.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705,

708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Because claims 29-37 recite a positively recited feature not disclosed by Fajkowski, i.e., the feature of "tokens encoded in a document that point to another document," Fajkowski does not anticipate claims 29-37. Accordingly, the rejection should be withdrawn.

The Office Action rejects claims 39-45 under 35 U.S.C. §103(a) over U.S. Patent No. 5,486,686 to Zdybel in view of U.S. Patent No. 5,331,547 to Laszlo. This rejection is respectfully traversed.

The Office Action tacitly admits that Zdybel does not disclose a token that links one paper document to another paper document. To rectify this shortcoming in Zdybel, the Office Action relies on Laszlo, which is alleged to disclose a token that links a paper document to at least one other paper document, referencing col. 4, lines 31-34, col. 5, lines 66-68 and col. 5, lines 1-4.

It is well settled that a rejection based on 35 U.S.C. 103 must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995); In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.

1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. However, the suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

The Office Action provides absolutely no motivation to combine the applied references. All that the Office Action does, is to speculate about what would happen if the two references were combined, to wit: "[T]his modification basically expands the range of links for Zdybel's tokens." This not even a broad conclusionary statement concerning motivation to combine the references. It is simply a statement of what might happen if these two references are somehow combined. Moreover, the Office Action is completely silent as to how Zdybel is to be modified in view of Laszlo.

As is well settled, the factual basis of a Section 103 rejection must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he advances. He or she may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Applicants respectfully submit that the only reason for combining these references in whatever manner they have been combined is based solely on improper hindsight reconstruction of Applicants' invention based solely on Applicants' own disclosure.

Lastly, the Response to Arguments section of the outstanding Office Action, page 2, adds yet another ground of rejection not mentioned in the previous rejection, which has been repeated and made final.

The Office Action now states that "It is well known in the art that the bar code reader is a standard to obtain data from hardcopy documents. Zdybel and Lazlo use this technique in a major portion of their respective inventions. Therefore it would have been obvious to

modify Zdybel's document system with Lazlo's links to other documents in order to link other relevant electronic documents to Zdybel's hardcopy, such as in a multimedia presentation."

**Premature Final Rejection**

Applicants respectfully submit that this constitutes a new ground of rejection under 35 U.S.C. §103(a) which was not necessitated by Applicants' Amendment. As such the final rejection is improper and must be withdrawn.

**Merits of the New Rejection**

The new ground of rejection's motivational statement falls into the category of broad conclusory statements about the teaching of multiple references, standing alone, and, as such is not "evidence" of proper motivation to combine the two references.

Simply stating that two references use bar code readers to obtain information from hardcopy documents might be a good way to classify them, as putting them in the same class of the U.S. Patent Classification system, for example. However, simply because two patents generically use bar code readers to obtain information from hardcopy documents and may be classifiable in the same U.S. class, is not clear and particular evidence of a motivation to combine their teachings. If the rationale of the rejection is followed, then simply classifying patents in the same class would render such patents combinable under 35 U.S.C. §103. This is not the standard.

Additionally, the new basis for rejection claims 39-45 speculates on operating a multimedia presentation. However, the rejection does not indicate any basis in the references for this use of either reference. It is well settled that a rejection must be based on facts, not on speculation.

Accordingly, because the Office Action fails to make out a prima facie case of obviousness of claims 39-45, the rejection is improper and should be withdrawn.




Applicants respectfully submit that claims 29-37 and 39-45 are allowable and that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Applicants also request withdrawal of the finality of the outstanding rejection as premature.

Should the Examiner believe that there is anything further that would place the application in even better condition for allowance, Applicants invite the Examiner to contact Examiner's undersigned representative at the telephone number listed below.

Respectfully submitted,

  
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JAO:RJW/sxb

Date: November 10, 2003

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